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BASF Performance Products LLC			GLOBOY, JAMES C	
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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HUGO CAMENZIND and PETER HANGGI

Appeal 2009-014066
Application 10/526,694
Technology Center 1700

Decided: May 26, 2010

Before CATHERINE Q. TIMM, BEVERLY A. FRANKLIN, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

I. STATEMENT OF CASE

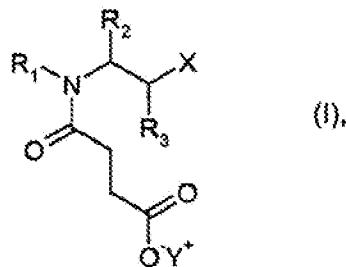
Appellants appeal under 35 U.S.C. § 134 from the Examiner's decision to reject claims 4-8 under 35 U.S.C. § 103(a) as unpatentable over Cox (US 4,882,077; issued Nov. 21, 1989) in view of Amende (DE 2 054 649; published May 10, 1972) and claims 4-6 and 8 under 35 U.S.C. § 103(a) as unpatentable over Kubo (US 5,362,375; issued Nov. 8, 1994) in view of Amende. We have jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM.

Appellants' invention relates to the use of compositions comprising succinic acid semi-amides to improve the corrosion protection properties of lubricants, such as hydraulic or metal-working fluids, greases, gear oils or engine oils (Spec. 1:1-3 and 21-24). Claim 4 is illustrative:

4. A composition comprising

a) At least one compound (I),

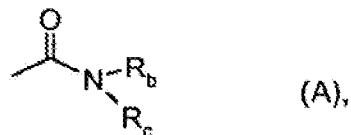


wherein

R₁ is a substituent selected from the group consisting of C₁-C₂₂alkyl, C₃-C₂₂alkyl interrupted by -O-, phenyl, and benzyl;

R₂ and R₃ are hydrogen;

X is derivatised carboxy selected from the group consisting of cyano, carboxy esterified by C₁-C₂₂alkyl, carboxy esterified by C₃-C₂₂alkyl interrupted by -O-, and carbamoyl of the partial formula (A)



defined as piperidinocarbonyl, piperazinylcarbonyl or morpholinocarbonyl; and Y+ is a hydrogen ion, ammonium, (C₁-C₄alkyl)₁₋₄ ammonium or (2 hydroxyethyl)₁₋₄ ammonium; and

b) A base oil of lubricating viscosity.

II. DISPOSITIVE ISSUES

The following two issues arise from the contentions of the Examiner and the Appellants:

Does the evidence support the Appellants' view that the Examiner erred in concluding that one of ordinary skill in the art would have used the compound (I), as disclosed in Amende, as the emulsifier in the compositions taught by Cox and Kubo?

Does the evidence of unexpected results provided by Appellants in Appellants' Specification, when all the evidence is weighed anew, support a conclusion of non-obviousness?

We answer these questions in the negative.

III. DISCUSSION

The Examiner relies on the teachings of Cox and Kubo as evidence that a composition containing a base lubricating oil and an emulsifier was known to those of ordinary skill in the art. The Examiner relies on Amende as evidence that compound (I) was a well-known emulsifier. The Examiner concludes that it would have been obvious to one of ordinary skill in the art to use the compound (I) of Amende in the compositions of Cox and Kubo, as Amende teaches that the compound acts as an emulsifier. (Ans. 3-5.)

Appellants contend that of the unlimited number of emulsifiers, the Examiner has provided no reason why the ordinary artisan would have looked to compound (I) of Amende (Br. 5, 6).

Except for those findings that we expressly overturn or set aside below, we adopt the Examiner's findings in the Answer as our own. Additional findings of fact may also appear below.

Amende¹ is directed to salts of N-acyl-N-alkylaminopropionic acids that meet the features of compound (I) as recited in claim 4 and a process for preparing the compound (Amende 2, ll. 1-2). Amende teaches that the compound can be used as a textile auxiliary, as an emulsifier, as a wetting agent, as a dying auxiliary, or for the production of washing agents and soaps (Amende 2, ll. 10-13). Thus, we agree with the Examiner that Amende includes a broad disclosure of using compound (I) as an emulsifier separate and apart from the disclosure of using compound (I) in either the textile or washing agent arts. Thus, it is reasonable that one of ordinary skill in the art would have been just as likely to choose the emulsifier of Amende, as any other materials known to be emulsifiers, in the composition of Cox and Kubo. To do so would be no more than the predictable use of a known compound according to its established function as an emulsifier. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 417 (2007) (The question to be asked is “whether the improvement is more than the predictable use of prior art elements according to their established functions.”).

We find no distinction in the emulsifier taught by Amende and the emulsifiers taught by Cox and Kubo, and Appellants fail to provide any evidence or rationale for us to conclude that the emulsifier of Amende would not have been an emulsifier that one of ordinary skill in the art would have used in the compositions of Cox and Kubo.

Appellants further contend that the use of compound (I) provides unexpected and superior results when used in a composition with a lubricating base oil (Br. 6). Appellants refer to the results provided on page

¹ We refer to and cite to the English translation of Amende by McElroy Translation Company (PTO 09-4345 April 2009) made of record in the

21 of the Specification, which allegedly show that compositions with a base oil and compound (I) have improved corrosion resistance and improved compatibility with calcium ions over compositions that include only the base oil (Br. 6). The Examiner contends that the concentration range used to achieve the results on page 21, i.e. 300 to 600 ppm of compound (I), which equates to 0.3-0.6% by weight of compound (I), represents a tiny portion of the scope of the claims (Ans. 6).

To be probative of nonobviousness, the showing of unexpected results must be commensurate in scope with the claim. *See, e.g., In re Harris*, 409 F.3d 1339, 1344 (Fed. Cir. 2005) (“Even assuming that the results were unexpected, Harris needed to show results covering the scope of the claimed range. Alternatively Harris needed to narrow the claims.”); *In re Greenfield*, 571 F.2d 1185, 1189 (CCPA 1978) (“Establishing that one (or a small number of) species gives unexpected results is inadequate proof, for ‘it is the view of this court that objective evidence of non-obviousness must be commensurate in scope with the claims which the evidence is offered to support.’”) (*quoting In re Tiffin*, 448 F.2d 791, 792 (CCPA 1971)).

The Examiner is correct that claim 4 fails to recite any concentration range for the use of compound (I) in the lubricating base oil composition (*see* claim 4). Appellants’ data presented in Table 2 of the Specification reports results for a base formulation having no identified emulsifier and results for formulations including emulsifiers of the type claimed at a single molar concentration of 0.1 mmol/kg (0.03 to 0.06 wt%) (Spec. Example 5 at 19-20; Table 2 at 21). While we agree with Appellants that testing different species of the claimed composition at the same molar concentration provides

some evidence of what species among the claimed species might work best at that particular concentration, the data does not provide evidence of what species might work best at other concentrations, nor does the data provide evidence of unexpected results for the claimed emulsifiers in comparison to other conventional emulsifiers over the range of claimed concentrations. Thus, we agree with the Examiner that the scope of the evidence is not commensurate with the scope of the claims.

Moreover, we emphasize that the data on page 21 of Appellants' Specification only compares various compositions of base oil and compound (I) to a "base formulation" with no identified emulsifier (*see Spec. ¶* spanning pages 19-20). Cox and Kubo both teach advantages to using an emulsifier in a lubricating base oil composition. Appellants' data fails to show unexpected and superior results in using compound (I) over any other conventional emulsifier. Thus, the data fails to compare the disclosed invention with the closest prior art, i.e., formulations having other emulsifiers as suggested by Cox and Kubo. *See In re Baxter Travenol Labs.*, 952 F.2d 388, 392 (Fed. Cir. 1991) ("[W]hen unexpected results are used as evidence of nonobviousness, the results must be shown to be unexpected compared with the closest prior art.").

Accordingly, the evidence provided by Appellants, when all the evidence is weighed anew, is not sufficient to support a conclusion of non-obviousness.

IV. CONCLUSION

On the record before us² and for the reasons discussed above, we sustain the rejections maintained by the Examiner.

V. DECISION

The decision of the Examiner is affirmed.

VI. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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²Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make have not been considered and are deemed to be waived. *See* 37 C.F.R. § 41.37(c)(1)(vii) (2008).